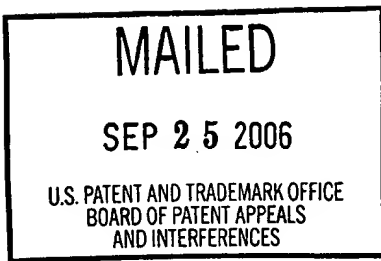


The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EUGENE J. ROLLINS, SAILENDRA PADALA
and NORBERT HENDRIKSE



Appeal No. 2006-2076
Application No. 09/747,651

HEARD: AUGUST 10, 2006

Before FRANKFORT, OWENS and NAPPI, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from a rejection of claims 1-31, which are all of the pending claims.

THE INVENTION

The appellants claim a method, computer readable medium and system for processing a request from a client for an electronic

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document located at a server. Claim 1 is illustrative:

1. A method for processing requests from a client for electronic documents located at a server, the method comprising the computer-implemented steps of:

receiving, by an intermediary disposed between the client and the server, a request from the client for an electronic document located at a first address at the server, the request made by a user at the client;

retrieving, by the intermediary, the electronic document from the first address;

retrieving, by the intermediary, information associated with the user;

generating an updated electronic document from the retrieved electronic document, said updated electronic document including at least a portion of the information associated with the user; and

providing the updated electronic document to the client for the user in response to the request.

THE REFERENCES

Godin et al. (Godin)	5,890,138	Mar. 30. 1999
Rhoads	6,285,776	Sep. 4, 2001
(effective filing date on or before May 6, 1998)		
Markus et al. (Markus '601)	6,490,601	Dec. 3, 2002
	(filed Jan. 15, 1999)	
Markus (Markus '042)	6,499,042	Dec. 24, 2002)
	(filed Oct. 1, 1999)	

THE REJECTIONS

The claims stand rejected as follows: claims 7 and 12 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention; claims 1, 2, 4, 6, 8-10, 12-16, 18, 20, 22-24 and 26-31 under 35 U.S.C. § 102(e) as anticipated by Markus '042;¹ claims 3 and 17 under 35 U.S.C. § 103 as obvious over Markus '042 in view of Markus '601; claims 5, 11, 19 and 25 under 35 U.S.C. § 103 as obvious over Markus '042 in view of Godin; and claims 7 and 21 under 35 U.S.C. § 103 as obvious over Markus '042 in view of Rhoads.

OPINION

We reverse the aforementioned rejections.

Rejection under 35 U.S.C. § 112, second paragraph

The examiner argues (answer, pages 3-4):

It is unclear based on the description in the specification and claims, how the tracer image is implemented in the present invention, and specifically what it's [sic] function is. As best understood, the tracer image appears to be some sort of authentication or other security measure,

¹ The statement of the rejection in the examiner's answer omits claims 30 and 31 (page 4). The examiner's discussion of those claims in the examiner's answer indicates that their omission from the statement of the rejection was inadvertent (page 10). Therefore, we consider claims 30 and 31 to be rejected.

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to restrict access to information.

The appellants' specification states: "Another solution to this problem [tracking transactions] involves the use of what are known as 'tracer images.' This generally involves merchants providing to all interested shopping applications data that uniquely identifies particular transactions and then relying upon shopping applications to claim origination of certain transactions" (page 5, lines 15-18).

The relevant inquiry under 35 U.S.C. § 112, second paragraph, is whether the claim language, as it would have been interpreted by one of ordinary skill in the art in light of the appellants' specification and the prior art, sets out and circumscribes a particular area with a reasonable degree of precision and particularity. See *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

The examiner's mere assertion that the function and implementation of the appellants' tracer image are unclear does not provide the required explanation as to why the claim language, as it would have been interpreted by one of ordinary skill in the art in light of the appellants' specification and the prior art, fails to set out and circumscribe a particular area with a reasonable degree of precision and particularity.

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Accordingly, we reverse the rejection of claims 7 and 21 under 35 U.S.C. § 112, second paragraph.

Rejections over prior art

We need to address only the independent claims, i.e., claims 1, 15 and 29. These claims require that a user at a client requests from an intermediary an electronic document located at a first address at a server. For this claim requirement the examiner relies upon Markus '042 (answer, page 4).

Markus '042 discloses that an external entity (user) instructs a document browser to request a document from a server which returns the document to the browser (col. 3, lines 21-25). The user then activates a form autofill trigger located in the document, thereby causing the document browser to contact a selective proxy which contacts the same server, requests from the server the same document, fills in the document, and sends the filled-in document to the document browser which displays it to the user (col. 3, lines 25-44).

The examiner argues that "[t]he autofill trigger serves as a request for the document located at a first address on the document server because the trigger results in the document being retrieved" (answer, page 9).

The appellants' claims do not merely require that a request by the user to the intermediary results in a document being retrieved from the server but, rather, require that the user actually requests from the intermediary a document located at the server. In Markus '042, at the time the user makes the autofill request to the selective proxy (intermediary), the user's client already has the document. The request by the user to the selective proxy is merely for the selective proxy to fill in the document. Markus '042 does not indicate that the user knows whether the selective proxy obtains the document from the server or from the user's client. Hence, Markus '042 does not indicate that the request from the user to the selective proxy to fill in the document is a request for the selective proxy to obtain the document from the server.

Also, the examiner does not explain how Marcus '042, alone or in combination with the other applied references, would have fairly suggested, to one of ordinary skill in the art, a request from the user to the selective proxy for a document located at the server.

The examiner, therefore, has not carried the burden of establishing a prima facie case of anticipation or obviousness of the appellants' claimed invention.

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DECISION

The rejections of claims 7 and 12 under 35 U.S.C. § 112, second paragraph, claims 1, 2, 4, 6, 8-10, 12-16, 18, 20, 22-24 and 26-31 under 35 U.S.C. § 102(e) over Markus '042, claims 3 and 17 under 35 U.S.C. § 103 over Markus '042 in view of Markus '601, claims 5, 11, 19 and 25 under 35 U.S.C. § 103 over Markus '042 in view of Godin, and claims 7 and 21 under 35 U.S.C. § 103 over Markus '042 in view of Rhoads, are reversed.

REVERSED

CHARLES E. FRANKFORT
Administrative Patent Judge

Terry J. Owens
TERRY J. OWENS
Administrative Patent Judge


ROBERT NAPPI
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES

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